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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,233	02/13/2006	Graham Simpson Murray	P01313-US-00 (13030.0012)	6252
22446	7590	02/05/2009	EXAMINER	
ICE MILLER LLP ONE AMERICAN SQUARE, SUITE 3100 INDIANAPOLIS, IN 46282-0200			THOMAS, JAISON P	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			02/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,233	Applicant(s) MURRAY ET AL.	
	Examiner Jaison P. Thomas	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/7/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Claims 1-11 in the reply filed on 11/17/2008 is acknowledged. The traversal is on the ground(s) that the 1) prior art resin is patentably distinct from the instantly claimed invention, 2) the prior art ester cannot perform a curing agent function and is identified as performing a different function, 3) and that no serious burden exists to search each of the groups designated, 4) all the claims contain a technical relationship involving a special technical feature and thus unity of invention exists. This is not found persuasive because 1) the Examiner does not conclude that the prior art resin and the instantly claimed resin are patentable distinct. Applicants attempt to distinguish the resins based specific process steps i.e. the presence of a high amount of sodium hydroxide reacted with the phenol. The Examiner notes, however, that the claims are merely drawn to a composition that contains alkaline salt, phenolic resole, ester and a conductive material. The claims make no mention of the reaction conditions to produce the resin and the Examiner declines in reading such limitations into the scope of the instant claims. Additionally, 2) the Examiner disagrees that the ester cannot perform a curing function. The Applicants allege that the ester compound in the prior art is a lubricant and cannot perform a hardening function. The Applicants cite an example of butyrolactone from the Specification and note that the esters of the prior art are not water-soluble as such and cannot perform the curing function as allegedly required. The Examiner respectfully

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disagrees and notes that the independent claims are not restricted to any particular type of ester and even if the art refers to esters in a different context, the Examiner assumes that the ester of Waitkus could inherently perform such a curing function as the phrase "ester-cured" in the claims is construed broadly and the Examiner believes the presence of any ester in the prior art composition, regardless of the described function, would meet said limitation. With respect to 3), the Examiner respectfully disagrees and notes that the conductive composition and its various device embodiments can span numerous classes and subclasses (e.g. Classes 252, 428, 429, 524 and others) involving a search of hundreds or thousands of patents and presents a significant burden upon the Examiner to search. Finally, with respect to 4), the Examiner reminds Applicants that in order for unity of invention to exist, a special technical feature must be present which unifies the various embodiments of the invention, however, the special technical feature must "define the contribution which each claimed invention, considered as a whole, makes over the prior art." See MPEP 1893.03(d). This contribution is adjudged by the standards of novelty or inventive step. See MPEP 1850 (II). The Examiner has provided a reference which the Examiner believes anticipates or makes obvious the claimed composition, and concludes that a special technical feature does not exist and thus there is a lack of unity of invention.

The Applicants are reminded that if the elected claims are found allowable, the withdrawn claims can be rejoined if they are drawn to the same limitations of the allowed claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner is unclear as to what structures are included in the phrase "substantially as hereinbefore described and/or illustrated with reference to Figures 3 and/or 4 of the drawings."

Correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lemon et al. (US Patent 5051454).

Lemon et al. teaches phenolic resin compositions which are comprised of esterified phenolic compounds, phenolic resin composition, and a base (Col. 2, lines 14-23). The phenolic resin composition is produced by the reaction of a phenol-reactive aldehyde, such as formaldehyde, and phenol in the presence of an alkali or alkaline earth metal compound as a catalyst (Col. 10, lines 30-41). The composition can contain glycol ethers which the Examiner construes as equivalent to a plasticizer (Col. 7, line 38). Application Example 4 suggests that the compositions of the prior art can be used to make bonded carbon electrodes (a cylindrical brick shape similar to the structure disclosed in the Specification) and the composition prepared in the example includes graphite filler (Col. 21, lines 24-68). The composition can also include conventional ester curing agents which are disclosed in Col. 11, lines 30-39.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaison P. Thomas whose telephone number is (571) 272-8917. The examiner can normally be reached on Mon-Fri 9:30 am to 6:00 pm.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. P. T./
Examiner, Art Unit 1796

/Mark Kopec/
Primary Examiner, Art Unit 1796